



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,509	04/05/2001	John Hindman	ODS-37	6107

1473 7590 12/18/2006
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK, NY 10020-1105

EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
----------	--------------

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/827,509

Applicant(s)

HINDMAN ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 & 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nevada Gaming Commission Regulation 26, Pari-Mutuel Wagering.

Claims 1, 7, 9: Applicant has claimed a method of projected effect of a proposed wager on pari-mutuel pools to a user. As Reg. 26 makes absolutely crystal clear, the odds and payout associated with a pari-mutuel wager must take into account all money wagered. Thus, in order to accurately determine the odds a wagerer will receive, any system must: (1) receive user input to propose a wager that is associated with at least one pari-mutuel pool; (2) obtain information that affects the user's potential winnings (i.e., pari-mutuel pool information -- current pool amount, commission, taxes, etc.) from the pool over some type of communications link; and provide the projected effect the user's proposed wager would have on the pari-mutuel pool to the user. No system could possibly provide accurate odds information to the wagerer without following these steps. Essentially, Applicant is attempting to patent providing accurate projected odds/payout information to the wagerer -- thus precluding anyone else in the United States from providing accurate odds/payout information. This is overbroad.

It is well known that wagerers desire to know how much they will be paid if they make a wager (i.e., projected odds/payout). Furthermore, it is well known that large wagers can have significant effects on the potential payout. This is a direct result of the method by which payouts of pari-mutuel pools are determined. It would have been obvious to one of ordinary skill in the art at the time of the invention to have a system (1) receive user input to propose a wager that is associated with at least one pari-mutuel pool; (2) obtain information that affects the user's potential winnings (i.e., current pool amount, commission, taxes, etc.) from the pool over some type of communications link; and provide the projected effect the user's proposed wager would have on the pari-mutuel pool to the user in order to calculate the projected odds/payout information as described in Reg. 26 and provide the user with information on how much they will be paid if they make a wager.

Claims 2-6, 18-22: As is made clear by Reg. 26, the wager amount, wager type, track, race & horse are all critical components in determining the payout. The wager type, track, race & horse identify the pari-mutuel pool. The amount is needed to calculate the gross amount wagered.

Claim 8: Reg. 26 requires those accepting pari-mutuel wagers to provide current odds. 26.100(6). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the current odds in order to comply with gaming regulations.

Claim 17: See claims 1 & 8.

3. Claims 10-16 & 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reg. 26 as applied to claim 1 or 17 in view of Mindes (US Patent Number 5,842,921).

Claims 10, 23: Reg. 26 teaches the method of determining accurate odds/payout information in pari-mutuel wagering. Reg. 26 does not, however, teach details of how this information might be provided to a wagerer. Mindes teaches a practical system for displaying proposed odds/payout information for proposed wagers including the potential effect the proposed wager would have on the pari-mutuel pool. (Col 14, 57 – Col 15, 33) Mindes teaches providing input via telephone. (Col 6, 29-32) The telephone is a ubiquitous device – virtually every household has one. This allows access to the system by more people, thus increasing the possible profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have a telephone as a part of the user interface in order to provide an appropriate input device while ensuring that most people have access to the system, thus increasing profit potential.

Claims 11, 12, 14, 16, 24, 25, 27, 31: As discussed in connection with claim 1, it is obvious to display/announce the projected effect of the proposed wager to the user in order to provide information on how much they will be paid if they make a particular wager.

Claims 13, 26: Mindes teaches a set top box (322) as a user interface.

Claims 15, 30: Mindes teaches a computer (302) as a user interface.

Claim 28: Mindes teaches displaying information about the game in windows. (Col 6, 33-38) While not disclosed in connection with a set top box, these windows serve to separate the information concerning different races, thus reducing player confusion. It would have been obvious to one of ordinary skill in the art at the time of the invention to

have displayed the projected effects information in a window on a television in order to separate the information concerning different races, thus reducing player confusion.

Claim 29: Mindes teaches displaying information about the game, including odds, in windows. (Col 6, 33-38) Mindes teaches that the window may occupy the entire screen.

It is well known to toggle between windows that fill the entire screen.

Response to Arguments

4. Applicant's arguments filed 23 August 2006 have been fully considered but they are not persuasive.

5. While the arguments are not persuasive, Examiner is taking this opportunity to clarify his position that the manner in which pari-mutuel odds/payouts are calculated, renders the claimed method obvious. No one can possibly provide accurate projected odds information without following the method of claim 1. It is simply not possible to do so. Furthermore, it is obvious to provide projected odds/payouts to a potential wagerer. The fact that large wagers may affect the odds is so well known that it has found its way into literature. As pointed out previously, this phenomenon is even mentioned in Ian Fleming's book, *Diamonds Are Forever*. (Page 60 of the 2003 Penguin Edition: "Fourth race on Tuesday. The Perpetuities Stake. Mile and a quarter for Three Year Olds. And put your money on just before the window closes. *You'll shift the odds with that grand of yours.* (Emphasis added.) Okay?") Thus, even general fiction teaches that an accurate calculation of the projected odds/payout must include information about the projected wager.

Conclusion

6. In view of the Appeal Brief filed on 23 August 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth above.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

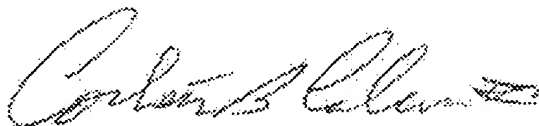
7. Should Applicant choose to initiate a new appeal, it is not necessary to include copies of material already in the file in the Evidence Appendix. The entire file is available to the Board.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CORBETT B. COBURN
PRIMARY EXAMINER

Corbett B. Coburn
Primary Examiner
Art Unit 3714

Robert Olszewski, SPE, 3714

 12/11/06

ROBERT P. OLSZEWSKI
SENIOR PATENT EXAMINER
TECHNOLOGY CENTER 3700 3700